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1   RECORD OF ORAL HEARING

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3   UNITED STATES PATENT AND TRADEMARK OFFICE

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6   BEFORE THE BOARD OF PATENT APPEALS

7   AND INTERFERENCES

8   ——————

9

10 Ex parte KEN A. BERKUN, AUSTIN D. DAHL, JENNIFER L. KOLAR,

11   SCOTT C. LEE, SHANNON E. MCRAE, BRAD S. MILLER, JOHN

12   PRINCE, ERIC C. REHM, SRINIVASAN SUDANAGUNTA, and

13   JONATHAN R. NOWITZ

14   ——————

15

16   Appeal 2008-3005

17   Application 09/876,943

18   Technology Center 2400

19   ——————

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21   Oral Hearing Held: March 18, 2009

22   ——————

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25 Before HOWARD B. BLANKENSHIP, JAY P. LUCAS, and THU A.

26 DANG, Administrative Patent Judges

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28 ON BEHALF OF THE APPELLANTS:

29

30   STEVEN LAWRENZ, ESQ.

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35

36   The above-entitled matter came on for hearing on Wednesday, March

37 18, 2009, commencing at 9:00 a.m., at The U.S. Patent and Trademark

38 Office, 600 Dulany Street, Alexandria, Virginia, before Victor Lindsay.

1   JUDGE BLANKENSHIP: -- introduce the panel, and I'd like to ask

2 you about claim 11.

3   MR. LAWRENZ: What can I tell you about claim 11?

4   JUDGE BLANKENSHIP: What are your plans for this claim?

5   MR. LAWRENZ: I'm, I'm not sure that we have specific plans for

6 this claim --

7   JUDGE BLANKENSHIP: Is this patent --

8   MR. LAWRENZ: -- other than to argue with patentability relative to

9 the rejections that are presently of record.

10   JUDGE BLANKENSHIP: Is claim 11 directed to statutory subject

11 matter?

12   MR. LAWRENZ: I believe that it is.

13   JUDGE BLANKENSHIP: How do you distinguish it from In re

14 Nuijten?

15   MR. LAWRENZ: I have a good faith belief that In re Nuijten was

16 incorrectly decided.

17   JUDGE BLANKENSHIP: Well, it's been denied cert at the Supreme

18 Court, so it's settled law.

19   MR. LAWRENZ: I'm not aware of, of any procedural options for

20 amending claim 11 during the course of this hearing so, so certainly if there

21 are new rejections about claim 11, we're very interested in addressing them

22 in any prosecution that would follow this appeal.

23   JUDGE BLANKENSHIP: All right, sir, claim 1, is this patentable

24 subject matter?

25   MR. LAWRENZ: I believe that it is.

1   JUDGE BLANKENSHIP: How does it pass a machine or

2 transformation test?

3   MR. LAWRENZ: It, it certainly transforms the metadata associated

4 with the, the metadata associated with the media file, and I would also

5 submit that the, the steps that are recited strongly implicate execution in a

6 specific computer system.

7   JUDGE BLANKENSHIP: All right, sir, you can now proceed.

8   MR. LAWRENZ: Thank you. This application is directed to the, the

9 field of media file search engines that enable users to identify media files

10 that have certain characteristics, and it solves the problem that while

11 metadata is often discoverable by, by crawlers used at the front end of search

12 engines, the, the -- that metadata discovered directly from the media files is,

13 is sometimes inaccurate which, if it's, if it's used in the index that's used to

14 serve queries by the search engine, can produce inaccurate results. The

15 solution that's addressed in the claims is that for at least certain metadata

16 fields, so title, artist for a, for a song and audio file, metadata field contents

17 that are obtained from the media file, parched from the media file, are

18 compared to contents of the same media data fields retrieved for that media

19 file from some authoritative source, a compilation of, of metadata known or

20 expected to, to be accurate, and if the contents do not match as a result of the

21 comparison, the metadata associated with the media file is, is modified such

22 as to correct it.

23   First I'd like to briefly talk about the rejection under section 112. In,

24 in my view there are two, two different opportunities for the panel to find

25 the, the language of the claim identified by the Examiner as not indefinite

26 and, and here the language is the, the use of the, the adjective

1   "authoritative." The, the first is to find it not, not indefinite as performing a

2   prescriptive role in the claim, that is as finding that it requires a particular

3   quality of the metadata in the source, those nouns that are modified by the

4   adjective and as set forth in our briefing. We believe that, that this term has

5   a, has a clear, plain meaning, that, that this plain meaning is clearly

6   identified in the specification and that the term is used consistently with that

7   meaning in the claims.

8   Alternatively, I believe the panel could find the -- this term not

9   indefinite as performing a descriptive role in the claim which is to say that

10   you could determine that it doesn't make any particular requirement on any

11   quality of the source or the -- of the metadata but rather it's, it's used as a

12   name for a source for metadata that's used as recited in the claim.

13   JUDGE LUCAS: Could -- Mr. Lawrenz --

14   MR. LAWRENZ: Yes.

15   JUDGE LUCAS: -- could you tell me where in the specification

16   the -- you define authoritative?

17   MR. LAWRENZ: I will be happy to address that question.

18   JUDGE LUCAS: Perhaps you could continue, and Ms. Kadoura

19   could look it up while we were hearing the rest of your argument.

20   MR. LAWRENZ: Very well. Thank you for the suggestion.

21   In, in that regard, I'd like to move to the prior art rejections. There

22   are, there are two elements of each of the independent claims that both of

23   the, the cited prior art references fail to disclose, and they are the, the second

24   and third elements of claim 1 for example. Srivastava is directed to -- it --

25   and it is Srivastava in the, the Examiner's prior art rejections that's relied

26   upon as disclosing these two elements. Srivastava is directed to the process

4

1   of compiling an XML database having metadata for media files, and the, the

2   logic that it uses to compile this database is that for a particular, for a

3   particular media file and for, for a particular metadata field, it first checks if

4   the metadata field is, is available directly from the media file. So it, it copies

5   that metadata field contents from the media file to the database. If not, it

6   consults an auxiliary source and, and attempts to copy a value for that, that

7   metadata field from the auxiliary source to the, the XML database.

8   In pursuing that logic, it does not compare the metadata -- any

9   particular piece of metadata, any contents of a particular metadata field from

10 the media file to corresponding contents for the, the media files from the

11 auxiliary source. Additionally, it fails to disclose the, the modifying act

12 recited in these claims in that the -- it makes no reference to, to changing the

13 metadata that's associated with the media file, but rather it's selecting what

14 metadata to store in this separate resource, the XML database.

15   Although the Examiner didn't argue that Chu discloses these elements,

16 they're also not present there, so the combination of Srivastava and Chu

17 doesn't supply these elements. Chu is directed to a system in which users

18 control files that can have metadata and, and these are the files that can

19 change the metadata. Periodically the, the metadata on those files is

20 compared to, to a central catalog of metadata and to the extent that the

21 metadata on the files doesn't match the, the metadata stored in the central

22 catalog. The metadata in the central catalog is updated to match the files.

23   Chu therefore also fails to disclose these two comparing and

24 modifying elements in that the -- because Chu always updates the central

25 catalog to reflect the metadata directly on the file, it, it clearly doesn't

26 consider the central catalog to be authoritative, and so comparing the

1   contents, the metadata contents on the file to the metadata contents of the

2   database isn't comparison of metadata contents on the file to an authoritative

3   source in the recited manner. Further, the -- it's clear that the modification in

4   Chu is performed with respect to the, the central catalog and, and not with

5   respect to the, the metadata associated with the media file.

6   To address specifically the, the rejection of claims 4 and 12, these

7   claims each recite determining whether a media file is unavailable or

8   corrupt, and if that's true, doing the comparison at a later time, because one

9   would imagine the comparison is impossible at a time when the media file is

10   unavailable or corrupt. This, this logic is, is simply not present in Chu. The

11   Examiner posits that in trying to do the, the comparison discussed before in

12   Chu that the comparison could fail because the, the pointer to the, to the file

13   that's used to retrieve the metadata from the file could, could have a problem

14   with it. This, this potential problem isn't disclosed by Chu. No logic for

15   handling this problem is, is disclosed by Chu, and so these, these elements of

16   claims 4 and 12 are similarly not disclosed by the, the combination of

17   Srivastava and Chu.

18   Are there any questions that the Board has about the, the positions

19   presented on the prior art rejections?

20   JUDGE LUCAS: No, sir, we have no questions.

21   MR. LAWRENZ: To, to return then to the, the question posed earlier

22   about definitions in the specification about the, the term "authoritative,"

23   the -- I think it's fair to say the, the detailed description does not contain an

24   explicit statement that has language like authoritative means or is defined to

25   mean. So perhaps there, there isn't an explicit definition contained in the

1 specification, but I'd like to point to several places in which the, the use of

2 the term renders clear, its meaning within, within the specification.

3   The -- if you'll turn your attention to page 5 of the published

4 application, and in particular, paragraph 45, the, the discussion of the

5 interpretative extraction, agent 68 --

6   JUDGE LUCAS: Okay. Is it possible that if you have --

7   JUDGE BLANKENSHIP: That's on page 17 of the specification we

8 have.

9   JUDGE LUCAS: Oh, thank you.

10   MR. LAWRENZ: I, I apologize. I'm, I'm sorry. Looking at a

11 different version. Let's see. If we can -- let me make sure that I'm, I'm

12 looking at a copy of the application that -- as filed that matches what, what

13 you are looking at.

14   So again this is paragraph 45 and grateful for the assistance of

15 pointing us to page 17 of the application as originally filed.

16   The -- there's the, the second sentence of this paragraph equates a

17 valid and authoritative metadata. Let me just read this. The interpretative

18 extraction 68 also corrects the title of the song from "I Am the Fishman" to

19 "We Are the Fishmen," because the database comprises valid or

20 authoritative metadata. So this, this equation of, of valid and authoritative to

21 us clearly demonstrates the use of authoritative to, to be synonymous with

22 valid.

23   JUDGE LUCAS: Would you say that "I Am the Fishman"

24 is a corruption of "We Are the Fishmen?"

25   MR. LAWRENZ: I -- can, can you tell me other, other than a media

26 file being broken, I'm not sure I, I appreciate the, the significance of the term

1   corruption in connection with this application. Is there a way you can be

2   more clear about the sense in which you're, you're considering that term?

3   JUDGE LUCAS: I believe the Chu reference was for correcting

4   corrupted data, right, and I am wondering whether your correction of "I Am

5   the Fishman" to "We Are the Fishmen" is because -- or let's take Paul

6   McCartney.

7   MR. LAWRENZ: Okay.

8   JUDGE LUCAS: Call McCartney would be a corruption of Paul

9   McCartney?

10   MR. LAWRENZ: Let's see. So I'm not --

11   JUDGE LUCAS: By the way --

12   MR. LAWRENZ: -- familiar with -- perhaps we can look together at

13   the, at the Chu reference to identify the, the portion that, that you're

14   recognizing as --

15   JUDGE LUCAS: I believe --

16   MR. LAWRENZ: -- discussing, addressing corruption?

17   JUDGE LUCAS: I believe the Chu reference you -- was

18   characterized by fixing problems in the data -- metadata caused by I believe

19   you said corruption or lack of the metadata. Is that --

20   MR. LAWRENZ: Are, are you talking about my discussion earlier of

21   the 102 rejection?

22   JUDGE LUCAS: Yes.

23   MR. LAWRENZ: Oh. So the -- my apologies. I, I may have

24   misspoke. So I don't understand, and I'm glad to have this opportunity to, to

25   clear up, I don't understand the Chu reference to address corruption at all. In

26   my reading of the Chu reference, it always expects that the, the file that's

1   being controlled by the user and being monitored by the system is available.

2   The Examiner in his rejection and subsequent argument has said that he

3   imagines a scenario where the, the reference is no longer effective to be able

4   to access that file and its metadata to do the comparison in Chu and he, he

5   goes on to say that there might be certain handling, air handling if that's true.

6   But I, I find nowhere in Chu that any disclosure as to either of those points.

7   My reading of Chu is that Chu always expects the metadata to be available

8   and has no logic for handling situations in which it's not.

9   JUDGE LUCAS: All right, I understand your situation, your

10 interpretation.

11   MR. LAWRENZ: Are there other questions from the panel that we

12 can address with our remaining time?

13   JUDGE BLANKENSHIP: We have no further questions.

14   MR. LAWRENZ: Thank you very much for your time today. We

15 certainly appreciate it.

16   (Whereupon, the hearing concluded on March 18, 2009.)